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OFFICE OF PETITIONS

In re Patent No. 6,841,359 : DECISION ON
Szostak et al. : REQUEST FOR RECONSIDERATION
Issue Date: January 11, 2005 : OF
Application No. 10/004,381 : PATENT TERM ADJUSTMENT
Filed: October 31, 2001 : and
Attorney Docket No. 00786/388002 : NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed March 10, 2005. Patentees request that the patent term adjustment indicated in the patent be corrected from sixty-seven (67) days to two hundred twenty-nine (229) days.

The request for reconsideration of patent term adjustment is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of one hundred twenty-two (122) days.

On January 11, 2005, the above-identified application matured into U.S. Patent No. 6,841,359, with a revised patent term adjustment of 67 days. On March 10, 2005, patentees timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct

number of days of Patent Term Adjustment is 229 days. Patentees dispute the reduction of 90 days for the filing of an Information Disclosure Statement after the mailing of the notice of allowance and the reductions of 55 and 17 days for papers filed November 1, 2004, including a request to initialize and return form PTO-1449 and a copy of the IDS previously filed.

Patentees' arguments and evidence have been considered, but not found entirely persuasive. The IDS filed August 3, 2004, was filed after the mailing of the notice of allowance on July 28, 2004. Moreover, the IDS did not include, as maintained by patentees, a § 1.704(d) statement.

Applicants are reminded that § 1.704(d) was revised, effective May 24, 2004, as follows:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Thus, it is concluded that the filing of the IDS after the mailing of the notice of allowance properly caused a reduction of the PTA. Moreover, the period of reduction is 107 days, counting the number of days beginning on the date of filing of the IDS, August 3, 2004, and ending on the date of mailing of a response by the Office, November 17, 2004.

The reductions associated with applicants filing of papers on November 1, 2004 have been considered. A review of the record reveals that on that date applicants made a Request for an Initialed IDS, supplying a copy of the IDS filed August 3, 2004 with the request; declared their Large Entity Status; and paid the Issue Fee. It is undisputed that a period of reduction of 4 days was properly entered for payment of the Issue Fee on that date.

Under the circumstances the filing on November 1, 2004 of the IDS along with a letter requesting return of an initialed IDS should not be considered "a failure to engage in reasonable efforts" to conclude processing or examination of an application and should not result in reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10). The Communication filed November 1, 2004, requesting the IDS be initialed was the first opportunity by applicants to address the matter. The IDS itself was not filed until after the mailing of the notice of allowance. Thus, the reduction of 17 days associated with the filing of this paper is not warranted.

The other paper filed November 1, 2004, was a statement of loss of entitlement to small entity status. By Official Gazette Notice dated June 26, 2001, the Director has advised applicants and patentees that the filing after the mailing of a Notice of Allowance of either a response to the examiner's reasons for allowance, a change of address, or a loss of entitlement to small entity status, will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and will not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10) Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance, 1247 OG 111 (June 26, 2001). A review of the application record supports a conclusion that the reduction of 55 days was based on the filing of such a paper after allowance. Thus, it is concluded that the reduction of 55 days is incorrect.

In view thereof, the patent should have issued with a patent term adjustment of 122 days.

Receipt of the \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **ONE HUNDRED TWENTY-TWO (122) days.**

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Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

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Enclosure: Copy of DRAFT Certificate of Correction